

AUS920010836US1

REMARKS

Claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69 stand rejected under 35 U.S.C 102(e) as being anticipated by Newman *et al.* (U.S. Patent No. 5,946,654). Claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 stand rejected under 35 U.S.C § 103(a) as being unpatentable over Hou *et al.* (EP 0585004) in view of Slusky (U.S. Patent No 5,487,111). As will be shown below, Newman, Hou, or Slusky, alone or in combination, do not teach a method, system, or computer program product for "determining a call backup" including "detecting a context," "selecting at least one backup party from among a plurality of backup parties to said intended party according to said context of call" as claimed in the present application. Claims 1-71 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-71.

Claim Rejections – 35 U.S.C. §102

Claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69 stand rejected under 35 U.S.C 102(e) as being anticipated by Newman *et al.* (U.S. Patent No. 5,946,654). To anticipate the claims of the present invention under 35 U.S.C § 102(e), two basic requirements must be met. The first requirement of anticipation is that Newman must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that Newman must enable Applicants' claims. Newman does not meet either requirement and therefore does not anticipate Applicants' claims. The rejection of Applicants' claims should be therefore withdrawn. Applicants specifically demonstrate the patentability of claims and respectfully request reconsideration of their patentability.

For convenient reference, please note that independent claim 1 claims:

A method for determining a call backup, comprising:

detecting a context for a call from a caller to an intended callee; and

AUS920010836US1

automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call.

Newman Does Not Disclose

Each and Every Element of Applicants' Claims

Newman does not disclose each and every element of Applicants' claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be shown below, Newman does not anticipate each and every element of claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69. Claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69.

Newman Does Not Disclose 'Detecting a Context'

Newman does not disclose "detecting a context" as claimed in the present application. The Office Action bases its rejection on the rationale that a voice messaging system in which a speaker identification system is implemented to work with a aforementioned voice messaging system in order to provide the user with the likely identity disclosed in Newman at col. 8, lines 36-40, is "detecting a context" as claimed in claim 1 of the present patent application.

Applicants in response respectfully note that Newman at col. 8, lines 36-40, discloses a speaker identification system for identifying the caller who has left a message. The caller in Newman leaves a message and concludes the call. Then Newman invokes a voice recognition module to detect the caller's identity. At the time when Newman detects the caller's identity, there is no call. The call is already terminated. There is no call at that

AUS920010836US1

point in Newman, and there could not possibly therefore be a call context as claimed in the present application. Newman detects only the caller's identity. There is no disclosure of a call context in Newman, nor could there be.

Applicants respectfully note that a speaker identification system for identifying the caller who has left a message of Newman is not "detecting a context" as recited in claims voice messaging system in order to provide the user with the likely identity disclosed in Newman at col. 8, lines 36-4, but instead is a speaker identification system for identifying the caller who has left a message. In fact, Newman, in teaching detecting caller identity without the presence of a call specifically teaches away from the 'detecting a context for a call' as claimed in the present application. That is, Newman specifically teaches a speaker identification system for identifying the caller who has left a message in a previously terminated call – a situation in which there cannot be a call context because there is no call. Because Newman does not disclose "detecting a context" and instead teaches a speaker identification system for identifying the caller who has left a message, the rejection of claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69 should be withdrawn.

Newman Does Not Disclose 'Selecting a Backup Party'

The Office Action states that Newman's "the user may configure a controller of the system to call the user's home telephone, portable telephone, pager, etc. ... when a message is received from a particular person ..." as disclosed in Newman at col. 8, lines 40-44, anticipates "automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context of said call" as claimed in the present application. Newman at col. 8, lines 40-44 does not disclose "selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call" as claimed in claim 1 of the present application. If fact, there is not one word in Newman that discloses in any way "selecting at least one backup party from among a plurality of backup parties to said intended party

AUS920010836US1

according to said context for said call" within the meaning of claims in the present application.

After detecting identity, the system of Newman places a second, separate call to the original callee. There is no mention of a backup party in Newman. The word 'backup' does not occur in the entire Newman patent, not once. The second call in Newman is a separate call to the original callee, not a selection of a backup for the same call as claimed in the present application. Applicants respectfully note that Newman at col. 8, lines 40-44, is a discussion of Figure 9 that provides an example of a configuration of a controller for a voice messaging system. The system of Newman simply places a call, with a voice message, not to a backup, but to the original callee. The voice messaging system in Newman is completely incapable of call administration, particularly detecting a context for a call or selecting a backup for the same call.

Claims 2-25

Claims 2-25 depend from independent claim 1 and include all of the limitations of claim 1. Because Newman does not disclose each and every element of claim 1, Newman does not disclose each and every element of claims 2-25. As such, claims 2-25 are also patentable and should be allowed.

Claims 26 and 51

Independent claim 26 and 51 recite system and computer program product claims corresponding to independent claim 1 that include "means for" and "means, recorded on [a] recording medium," for determining a call backup, comprising: detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call. Therefore, for the same reason that Newman does not disclose a method for determining a call backup, comprising: detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from

AUS920010836US1

among a plurality of backup parties to said intended party according to said context for said call, Newman also does not disclose a system or computer program product for determining a call backup, comprising: detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call as claimed in independent claims 26 and 55. Independent claims 26 and 55 as well as their rejected dependent claims are patentable and should also be allowed.

Newman Is Not An Enabling Disclosure of Applicants' Claims

There are two required aspects of anticipation. Not only must Newman disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate Applicants' claims, but also Newman must be an enabling disclosure of Applicants' claims within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless Newman places Applicants' claims in the possession of a person of ordinary skill in the art, Newman is legally insufficient to anticipate Applicants' claims under 35 USC 102(e).

Newman cannot possibly place into the possession of a person of ordinary skill in the art the 'detecting a context' and 'selecting a backup party' as claimed in the present invention. The 'Technical Field' as recited in the present invention is:

AUS920010836US1

The present invention relates in general to telecommunications and, in particular, to voice identification. Still more particularly, the present invention relates to identifying a backup for a call according to the call context.

Applicants respectively propose that a person of ordinary skill in the art in this case is a person with skills in telecommunications, voice identification, context detection, and backup selection. Newman does not contain the word 'backup.' Newman does not contain the word 'telecommunication.' Newman teaches a voice messaging system that places a separate, second call to an original callee. Newman does not pretend to teach telecommunications that include context detection or backup selection. Newman therefore does not place one of ordinary skill in the art in possession of claim 1 and is therefore legally insufficient to anticipate claim 1.

Claims 2-25

Claims 2-25 depend from independent claim 1 and include all of the limitations of claim 1. Because Newman does not place one of ordinary skill in the art in possession of claim 1, Newman does not place one of ordinary skill in the art in possession of claims 2-25. As such, claims 2-25 are also patentable and should be allowed.

Claims 26 and 51

Independent claim 26 and 51 recite system and computer program product claims corresponding to independent claim 1 that include "means for" and "means, recorded on [a] recording medium," for determining a call backup, comprising: detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call. Therefore, for the same reason that Newman does not enable a method for determining a call backup, comprising: detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for

AUS920010836US1

said call, Newman also does not enable a system or computer program product for determining a call backup, comprising: detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call as claimed in independent claims 26 and 55. Independent claims 26 and 55 as well as their rejected dependent claims are patentable and should also be allowed.

Claim Rejections – 35 U.S.C. § 103

Claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hou *et al.* (EP 0585004) in view of Slusky (U.S. Patent No. 5,487,111). Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Hou and Slusky. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Hou and Slusky. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Hou and Slusky must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As demonstrated below, the combination of Hou and Slusky establishes a prima facie case of obviousness. The rejection of claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 should therefore be withdrawn and the case should be allowed.

Hou and Slusky

Claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hou *et al.* (EP 0585004) in view of Slusky (U.S. Patent No.

AUS920010836US1

5,487,111). The combination of Hou and Slusky cannot establish a prima facie case of obviousness because the proposed combination does not teach each and every element of claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

The Combination Of Hou and Slusky Does
Not Teach all Of Applicants' Claim Limitation

The combination of Hou and Slusky does not teach or suggest all of Applicants' claim limitations. Independent claim 1 claims:

A method for determining a call backup, comprising:

detecting a context for a call from a caller to an intended callee; and

automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call.

The following discussion considers each element of claim 1 in sequence:

The Combination of Hou and Slusky Does Not Teach
or Suggest Detecting A Context or Selecting a Backup

The Office Action states that Hou at col. 4, lines 6-25, teaches "a system in which a subscriber may place a call to a particular location (e.g. home) based on the use of a voice identified label that is associated with subscriber's telephone number." That is, the Examiner argues that the voice identification labels in Hou disclose 'contexts' as claimed in the present application. Applicants in response respectfully note that a 'context' as claimed in the present application is a telecommunications data structure used to select a backup party for a call. In contrast, however, the voice identification labels of Hou are

AUS920010836US1

used only to identify a primary callee. The data structures disclosed in Hou are mere "voice-identified calling labels" associated with telephone numbers. These structures from Hou do not even remotely disclose contexts as claimed in the present application. Hou, at column 4, lines 6-25, discloses nothing whatsoever, not one word, about selecting a backup party for a call. Hou therefore cannot possibly be said to teach or suggest a 'context' or 'detecting a context' within the meaning of the claims in the present application.

The Office Action notes that Hou does not disclose "automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context of call." Office Action dated July 8, 2004, page 5. The Office Action states that Slusky at lines 1-4 of the Abstract, teaches "a method for use in a telecommunications system in which a call sequencing facility allows a caller who is trying to reach a called subscriber to be routed to each of a sequence of telephone numbers specified by the subscriber." That is, the Examiner argues that routing a caller to a sequence of telephone numbers in Slusky discloses "selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call" as claimed in the present application.

Applicants in response respectfully note that routing a caller to a sequence of telephone numbers in Slusky is not "selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call" as claimed in the present application. Slusky, at lines 1-4 of its Abstract, discloses nothing whatsoever, not one word, about selecting a backup party for a call to said intended party according to said context for said call. What Slusky actually discloses at Abstract lines 1 – 4 is:

A method for use in telecommunications system in which a call sequencing facility allows a caller who is trying to reach a called subscriber to be routed to each of a sequence of telephone numbers specified by the subscriber ...

AUS920010836US1

That is, Slusky discloses a sequence of numbers to be called in trying to reach a subscriber – and Slusky calls all the numbers in the sequence with no selection or selectivity at all – which clearly is not ‘selecting a backup’ as claimed in the present invention. Slusky therefore cannot be said to teach or suggest ‘selecting a backup party for a call to said intended party according to said context for said call’ within the meaning of the claims in the present application. Because neither Hou nor Slusky disclose “detecting a context for a call from a caller to an intended callee; and automatically selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call” as claimed in the present application. The proposed combination of Hou and Slusky therefore cannot establish a prima facie case of obviousness. The rejection of claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 should therefore be withdrawn and the case should be allowed.

No Suggestion or Motivation to Modify Hou Or
To Combine Hou and Slusky

To establish a prima facie case of obviousness, there must be a suggestion or motivation to modify Hou. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to modify Hou must come from the teaching of Hou itself, and the Examiner must explicitly point to the teaching within Hou suggesting the proposed modification. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action at pages 5 and 6 states its rationale for motivation to combine as:

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify Hou’s et al. system by adding the sequence calling

AUS920010836US1

feature as taught by Slusky, and thus in this manner provide the called subscriber with alternate means to be reached if the person is not available on the main line.

The suggestion to modify Hou must come from a teaching within Hou, not from Slusky. The Examiner must point to teaching within Hou suggesting that Hou be modified to add Slusky's number sequences. It is not possible to find such a teaching in Hou because Hou is concerned with voice identification labels that are used only to identify a primary callee, not "detecting a context" and "selecting at least one backup party from among a plurality of backup parties of said intended party according to said context for said call" according to context within the meaning of the claims of the present application. Hou is concerned with taking a message and calling the original callee in a separate call with a voice message, not with selecting a backup for a current call. Clearly Hou has no interest in the kind of calling sequence disclosed in Slusky. The Examiner has not pointed to any disclosure in Hou suggesting "detecting a context" according to context within the meaning of the claims of the present application, and as this reasoning shows, it is not possible to do so. Absent a showing of motivation to combine in Hou, the Examiner has impermissibly used hindsight occasioned by Applicants' own teaching to reject the claims. As such, the proposed modification of Hou or the combination of Hou and Slusky cannot establish a prima facie case of obviousness. The rejection of claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 should therefore be withdrawn and the case should be allowed.

No Reasonable Expectation of Success in the
Proposed Combination of Hou and Slusky

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed modification of Hou. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). There can be no reasonable expectation of success in a proposed modification if the proposed modification changes the principle of operation of Hou. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

AUS920010836US1

Hou teaches a 'voice identification labels that are used only to identify a primary callee.' Hou, Col. 4, lines 6-25. Voice identification labels in Hou are not "context" or "detecting a context" as claimed in the present application. Slusky teaches "a method for use in a telecommunications system in which a call sequencing facility allows a caller who is trying to reach a called subscriber to be routed to each of a sequence of telephone numbers specified by the subscriber." Slusky, Abstract, lines 1-4.

Routing a caller to sequence of telephone numbers in Slusky is not "selecting at least one backup party from among a plurality of backup parties to said intended party according to said context for said call" as claimed in the present application. The principle of operation of Hou, a voice identification label identifying a single telephone number, obviously is changed completely, and in fact will not function at all, with the addition of routing a call to a sequence of telephone numbers from Slusky. That is, in order to modify the voice identification labels in Hou to include the routing of a caller to sequence of telephone numbers disclosed in Slusky would destroy the intent, purpose, and function of the invention disclosed in Hou. The proposed combination of Hou by Slusky therefore cannot possibly support a *prima facie* case of obviousness. The rejection of claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 should therefore be withdrawn and the case should be allowed.

Rejections of Independent and Dependent Claims

The Office Action rejects all the independent claims, that is, claims 1, 26, 51, 62, 70, and 71, on the same rationales. Applicants respectfully propose therefore that all the independent claims should stand on the same grounds, those set forth above in this Response. Because all the independent claims stand, all the dependent claims stand.

Conclusion

Claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69 stand rejected under 35 U.S.C 102(e) as being anticipated by Newman *et al.* (U.S. Patent No. 5,946,654). Newman

AUS920010836US1

does not anticipate claims 1, 4, 14, 16-17, 26, 29, 39, 41, 51, 54, and 69. Claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over unpatentable over Hou *et al.* (EP 0585004) in view of Slusky (U.S. Patent No. 5,487,111). For the reasons set forth above, however, the proposed modification of Hou in view of Slusky or the proposed combination of Hou and Slusky fails to establish a *prima facie* case of obviousness because the proposed modification or combination does not teach each and every element of claims 1-3, 5-8, 19-33, 44-66, 68, and 70-71, there is no suggestion or motivation to make the proposed combination, and there is no reasonable expectation of success in the proposed combination.

Reconsideration of claims 1-71 in light of the present remarks is respectfully requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 10 · 7 · 04 By:



John Biggers
Reg. No. 44,537
Biggers & Ohanian, LLP
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS